

DEC 12 2005

BLAKELY 1279 OAKMEAD PARKWAY
SOKOLOFF SUNNYVALE, CALIFORNIA 94086
TAYLOR & (408) 720-8598 (Telephone)
ZAFMAN (408) 720-9397 (Facsimile)

A LIMITED LIABILITY
PARTNERSHIP INCLUDING
LAW CORPORATIONS

FACSIMILE TRANSMITTAL SHEET (TRANSMITTAL TO PTO)

Deliver to: William C. Vaughn, Jr.
Firm Name: U.S. PATENT AND TRADEMARK OFFICE
Fax Number: 571-273-8300 Telephone No. _____
From: Carrie Boccaccini
Date: December 12, 2005 Time: _____
Operator: Carrie Boccaccini Matter: 6783.P010
Number of pages including cover sheet: 6
In Re Patent Application of: Shekhar Kirani
Application No.: 09/900,384
Filed: July 6, 2001
For: System and Methodology for Optimizing Delivery of Email Attachments for Disparate Devices

Comments:

*per our conversation earlier today,
please consider the proposed agenda for
a phone interview. Thank you for
your time and attention.*
Sincerely, Elena Dreszer

CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being facsimile transmitted to the Patent and Trademark Office on:

Date of Transmission December 12, 2005

Carrie Boccaccini

(Typed or printed name of person transmitting paper)

Carrie Boccaccini
(Signature of person transmitting paper)

CONFIDENTIALITY NOTE

The documents accompanying this facsimile transmission contain information from the law firm of Blakely Sokoloff Taylor & Zafman LLP that is confidential or privileged. The information is intended to be for the use of the individual or entity named on this transmission sheet. If you are not the intended recipient, be aware that any disclosure, copying, distribution, or use of the contents of this faxed information is prohibited. If you have received this facsimile in error, please notify us by telephone immediately so that we can arrange for the retrieval of the original documents at no cost to you.

IF YOU EXPERIENCE ANY DIFFICULTY IN RECEIVING THE ABOVE PAGES, PLEASE CALL (408) 720-8598 AND ASK FOR THE OPERATOR NAMED ABOVE.

(Rev. 11/23/97)

RECEIVED
CENTRAL FAX CENTER

DEC 12 2005

Docket: 006783.P010PatentIN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Shekhar Kirani

Application No: 09/900,384

Filing Date: July 6, 2001

For: System and Methodology for
Optimizing Delivery of Email
Attachments for Disparate Devices

Examiner: William C. Vaughn, Jr.

Art Unit: 2143

Confirm. No. 7192

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450PROPOSED AMENDMENT AND RESPONSE TO FINAL OFFICE ACTION

Sir:

In response to the Final Office Action mailed on October 12, 2005, and as discussed earlier today, December 12, 2005, please consider the following amendments and remarks.

Claim 1, as currently presented, reads as follows:

1. (Previously presented) In an online messaging system supporting transmission of attachments, a method for automatically processing messages containing attachments, the method comprising:
 - specifying a preference for formatting attachments that accompany messages;
 - receiving a particular message having a particular attachment;
 - responsive to identifying the particular attachment as exceeding capabilities of an intended recipient's receiving device, removing the particular attachment from the particular message and inserting a link into the particular message, said link capable of referencing the particular attachment that has been removed;
 - delivering the particular message to the intended recipient; and
 - in response to invocation of the link by the intended recipient, retrieving a copy of the particular attachment that is automatically formatted based on the specified preference.

As correctly stated in the Office action, Rabe-Hesketh fails to disclose or suggest that the removing of a particular attachment is "responsive to identifying the particular attachment as **exceeding capabilities of an intended recipient's receiving device.**" The Office action combined Rabe-Hesketh with Gabrielsson to show this feature.

Gabrielsson is directed at a method of organizing incoming electronic messages for a user who can access her messages via at least two different types of access environments. Specifically, in Gabrielsson, the decision to "thin" an electronic message

is based on predefined user preferences (Gabrielsson, Fig. 3; p. 13, ll. 20-27), such that a separate message version is created for each type of access environment (Gabrielsson, p. 9, ll. 14-17). Thus, in Gabrielsson, if the user specified preferences as described with reference to Figure 5 and accesses the messages via an Ethernet connection using a Netscape client, a message would be presented to the user in their original format (Gabrielsson, p. 13, ll. 28-32), even if the message includes an extraordinary multimedia attachment that exceeds the capabilities of the user's access environment.

In contrast, claim 1 recites "removing of a particular attachment" "responsive to identifying the particular attachment as **exceeding capabilities of an intended recipient's receiving device.**"

Thus, Gabrielsson, whether considered separately or in combination with Rabe-Hesketh, fails to disclose or suggest either "removing of a particular attachment" or that that the removing of a particular attachment is "responsive to identifying the particular attachment as **exceeding capabilities of an intended recipient's receiving device,**" as recited in claim 1 and 51 as amended.

Because the combination of Gabrielsson and Rabe-Hesketh fails to disclose or suggest each and every element of claim 1, claim 1, its dependent claims, are patentable and should be allowed.

In the alternative Applicant suggests an amendment clarifying that "removing of a particular attachment" is responsive to determining the intended recipient's receiving device and responsive to identifying the particular attachment as exceeding capabilities of an the intended recipient's receiving device, as indicated below.

1. (Currently Amended) In an online messaging system supporting transmission of attachments, a method for automatically processing messages containing attachments, the method comprising:

specifying a preference for formatting attachments that accompany messages;

receiving a particular message having a particular attachment;

determining an intended recipient's receiving device;

responsive to determining the intended recipient's receiving device and
responsive to identifying the particular attachment as exceeding capabilities of ~~an~~ the
intended recipient's receiving device, removing the particular attachment from the
particular message and inserting a link into the particular message, said link capable of
referencing the particular attachment that has been removed;


delivering the particular message to the intended recipient; and

in response to invocation of the link by the intended recipient, retrieving a copy of
the particular attachment that is automatically formatted based on the specified
preference.

Applicant would like to thank Examiner in advance for granting a telephone
interview at (408) 720-8300.

Respectfully submitted,
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Dated: _____


Elena B. Dreszer
Reg. No. 55,128

Customer No. 08791
12400 Wilshire Blvd.

Serial. No.: 09/900,384

4

Docket No.: 006783.P010

Seventh Floor
Los Angeles, CA 90025
(408) 720-8300